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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,351	02/10/2004	Warren M. Farnworth	6105US (03-0885.00/US)	3156
24247	7590	03/23/2006	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			KOCH, GEORGE R	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 03/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,351

Applicant(s)

FARNWORTH, WARREN M.

Examiner

George R. Koch III

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ushijima (US 5,393,624).

Ushijima discloses system for selectively depositing a material on a previously formed workpiece, comprising a platform (Figure 2, item 10) for supporting the workpiece during a deposition process, a sensing system (Figure 2, items 15, 16, and 507) for measuring an upper surface of the workpiece and a surface level of a material deposited on the upper surface of the workpiece until the surface level of the material corresponds to a specific thickness of the material (see, for example, Figures 10 and 11); and a deposition system (item 13) for depositing the material on the workpiece to the specific thickness as monitored by the sensing system (see Figures 10 and 11). The apparatus can operate on the claimed die and claimed surfaces.

This sensing system for measuring an upper surface is consider capable of measuring and upper surface *over a semiconductor die including the upper sufances and including a previous material previously deposited thereon*. This apparatus in Ushijima is considered *capable* of coating any type of substrate, including the claimed *semiconductor die including a previous material previously deposited thereon*.

As to claim 2, Ushijima discloses that the deposition system is a spin-coating deposition system (see Figures 10 and 11).

As to claim 3, Ushijima discloses that the sensing system includes a sensor (item 15) for both measuring the upper surface of the workpiece (prior to deposition) and for monitoring the surface level of the material deposited on the upper surface of the workpiece (during deposition).

As to claim 8, Ushijima discloses coating a semiconductor wafer (recited, for example, at column 4, line 65).

Claim Rejections - 35 USC § 103

3. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Ushijima as applied to claims 1-3 and 8 above, and further in view of Whitman (US 6,642,155).

As to claim 4, Ushijima discloses measuring the upper surface of the workpiece and the surface level of the deposited material (see rejection of claim 3 above), but does not disclose using separate sensors for each function.

However, Whitman discloses that it is known in measuring the thickness during spin coating operations to utilize multiple sensors. Whitman uses to the multiple sensors to track coated and uncoated areas in order to properly coordinate the coating operation (as described in column 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized such sensors in order to achieve coordination of the coating operation.

Response to Arguments

4. Applicant's arguments filed 3/2/2006 have been fully considered but they are not persuasive.

5. In response to applicant's arguments with respect to the 35 U.S.C. § 102 and 103 rejections (pages 9-12) that the prior art does not suggest a sensing system for *configured to measure over the semiconductor die both an upper surface including a previous material previously deposited thereon*, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the amendment is merely directed towards the structure of the substrate upon which the claimed apparatus operates upon. This sensing system in Ushijima for measuring an upper surface is consider capable of measuring and upper surface *over a semiconductor die including a previous material previously deposited thereon*. This apparatus in Ushijima is considered *capable* of coating any type of substrate, including the claimed *semiconductor die with such upper surfaces including a previous material previously deposited thereon*.

6. Applicant essentially argues that the semiconductor die as claimed prevents the apparatus from being used.

However, the material worked upon does not limit apparatus claims. MPEP 2115.

Art Unit: 1734

"Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)).

In *In re Young*, a claim to a machine for making concrete beams included a limitation to the concrete reinforced members made by the machine as well as the structural elements of the machine itself. The court held that the inclusion of the article formed within the body of the claim did not, without more, make the claim patentable.

In *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), an apparatus claim recited "[a] taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Note that this line of cases is limited to claims directed to machinery which works upon an article or material in its intended use. It does not apply to product claims or kit claims (i.e., claims directed to a plurality of articles grouped together as a kit).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Koch III whose telephone number is (571) 272-1230 (TDD only). If the applicant cannot make a direct TDD-to-TDD call, the applicant can communicate by calling the Federal Relay Service at 1-866-377-8642 and

Art Unit: 1734

giving the operator the above TDD number. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



George R. Koch III
Primary Examiner
Art Unit 1734

GRK
3/20/2006